

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT
OF THE TTAB

Mailed:
April 9, 2003
Paper No. 14
Bucher

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Ultra-Flex Moulding, Inc.

Serial No. 75/699,004

Marnie Wright Barnhorst of The Trademark Group for Ultra-Flex Moulding, Inc.

Tonja M. Gaskins, Trademark Examining Attorney, Law Office 112 (Janice O'Lear, Managing Attorney).

Before Hanak, Quinn and Bucher, Administrative Trademark Judges.

Opinion by Bucher, Administrative Trademark Judge:

Ultra-Flex Moulding, Inc. seeks registration on the Principal Register of the mark ULTRA-FLEX MOULDING as applied to "construction materials, namely non-metal molding" in International Class 19.¹

¹ Application Serial No. 75/699,004 was filed on May 6, 1999, based upon applicant's allegation of use in commerce since at least as early as 1989. The word "Moulding" is disclaimed apart from the mark as shown.

We take judicial notice (here and in later instances in this decision) of a dictionary listing [*University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983)] confirming that "molding" (taken from the identification of goods) and "Moulding" (taken from the mark) are both acceptable

The Trademark Examining Attorney has refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark, when applied to applicant's goods, so resembles two previously registered marks that are owned by two different entities: ULTRA-FLEX for "metal edge molding for suspension ceilings" in International Class 6² and ULTRAFLEX for "non-metal, prefinished drywall trim" in International Class 19,³ as to be likely to cause confusion, to cause mistake or to deceive.

When the refusals were made final, applicant appealed. Applicant and the Trademark Examining Attorney have fully briefed the case. Applicant did not request an oral hearing.

We affirm the refusals to register.

Applicant argues, in urging that the refusals be reversed, that the cited mark is so weak in this field that small distinctions like applicant's hyphen (absent in the '318 registration) and the addition of the word "Moulding"

spellings for the same word: **"molding or moulding:** ... 3b: a decorative plane or curved strip (as of wood or metal) used for ornamentation or finishing ... <baseboard *molding*> <edge *moldings* are designed to meet typical building conditions - Sweet's Catalog Service> ... " Webster's Third New International Dictionary of the English Language, Unabridged (1993).

² Registration No. 1,863,049, issued on November 15, 1994, Section 8 affidavit accepted, Section 15 affidavit acknowledged.

³ Registration No. 2,222,318, issued on February 9, 1999.

to the end of applicant's mark are significant; that the purchasers of the involved goods are all sophisticated; and that there is no evidence in the record that these goods originate from the same source.

The Examining Attorney maintains that the word "Moulding" is not significant enough to create a different commercial impression from the cited marks; that the various goods are all construction materials in the nature of "trim"; that the goods are offered in connection with each other through the same channels of trade; that there is no actual showing in the file as to the sophistication of the purchasers, as argued by applicant; that third-party registrations showing a number of ULTRA and ULTRAFLEX marks are accorded little probative weight in this context; that applicant's allegation of an absence of actual confusion is not persuasive of a contrary result in this *ex parte* context; and finally, that the Office must resolve any doubt as to likelihood of confusion against applicant.

In the course of rendering this decision, we have followed the guidance of *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1362, 177 USPQ 563, 567-68 (CCPA 1973). The *du Pont* case sets forth the factors that should be considered, if relevant, in determining likelihood of confusion.

Relatedness of the goods:

We turn first to the du Pont factor focusing on the relatedness of the goods as described in the application and cited registrations. One of the cited registrations identifies the goods as "metal edge molding for suspension ceilings," while the second identifies the goods as "non-metal, prefinished drywall trim." Applicant's goods are identified as "construction materials, namely non-metal molding."

The first cited registration involves goods identified as "metal edge molding for suspension ceilings." Despite the obvious fact that both goods involve "molding," applicant argues that this registrant's product is "used to *structurally* secure suspension ceilings," and hence, "it has a different use and would not be confused with applicant's *decorative*, non-metal moldings."

We agree with applicant that registrant's metal molding is structural in nature, and would be used to hold up ceilings made of drywall and/or acoustical tiles. This metal edge molding for suspension ceilings might well include all the suspended metal framing out into the very center of the room, but as identified, would certainly

include the room perimeter trim - out on the edges of the ceiling, where the ceiling meets the walls.

As to applicant's decorative molding, it would certainly have to be read to include crown molding designed to cover any gap between the wall and the ceiling. Decorative crown molding would, by definition, not be used for structural purposes, and is rarely seen with suspended ceilings holding acoustical tiles. However, there is nothing in this record that would support the conclusion that decorative molding could not be combined with a suspended ceiling finished with drywall materials.

After all, it is sufficient that the goods are related in some manner and/or that the circumstances surrounding their marketing are such that they would be likely to be encountered by the same persons under situations that would give rise, because of the marks employed in connection therewith, to the mistaken belief that they originate from or are in some way associated with the same producer or provider. See Monsanto Co. v. Enviro-Chem Corp., 199 USPQ 590, 595-96 (TTAB 1978) and In re International Telephone & Telegraph Corp., 197 USPQ 910, 911 (TTAB 1978). Hence, from the perspective of those involved in the building trades, these two types of moldings may well be used in the same room and would be found on the same construction site or large remodeling job.

The second cited registration involves goods identified as "non-metal, prefinished drywall trim⁴."

Applicant argues as follows:

... [T]he Examining Attorney provides no evidence that Applicant's "non-metal moulding" could include "prefinished drywall trim." The Examining Attorney seems to be basing her position in part on the erroneously (sic) view that "moulding" and "trim" are used interchangeably in the construction industry. This is not the case. Trim and molding are two different types of constructions (sic) material and the Examining Attorney's records from the *X-Search Trademark Database* support this fact in that these records list "molding" and "trim" separately ... Furthermore, nothing in these records shows that Applicant's goods (moldings) and Registrant's goods (prefinished drywall trim) are likely to be marketed under the same trademark and within the same channels of trade.

(Applicant's appeal brief, p. 6).

The Trademark Examining Attorney has introduced into the record third-party registrations where molding and trim are included in the same listing of goods, and often in a compound manner. As seen in the dictionary definitions of

⁴ **Trim** ... 2b: material used as adornment, ornament, or trimming or fully or partly ornamental fixtures, (1) TRIMMING (2) the lighter woodwork or metal in the finish of a building (as a molded architrave around an opening to protect the plastering); also: an ornamental or protective framing (as of wood, metal or stone) around an opening or at a corner or eave ... <serve as architectural trim and have no structural value at all ... G.E. Serehan> ... Webster's Third New International Dictionary of the English Language, Unabridged (1993).

Trim: ... 24. Building Trades. finished woodwork or the like used to decorate or border openings or wall surfaces, as cornices, baseboard or moldings ... The Random House Dictionary of the English Language, Unabridged, 2nd Edition (1987).

"molding/moulding" and "trim," there are clearly similarities in the entries: (1) ornamental; (2) finishing; (3) composed of a number of different materials, including wood, metal, etc.; and (4) especially at cornices, baseboards, edges, corners, walls, frames around doors and windows, etc. While the range of adornments included in the ambit of building "trim" is broader than the more limited goods included in "molding," the definition of trim includes substantially all interior, decorative molding.

Applicant's earlier arguments as to how its goods do not share the structural nature of the goods in the first cited registration ('049) appear to hurt its argument herein related to the goods of the second registration. That is, to the extent building or architectural "trim" has no structural value, registrant's non-metal trim (of the '318 registration) would appear to be very similar to applicant's non-metal decorative molding. On their faces, the identifications of goods would both include, for example, molding or trim made of wood or vinyl. Moreover, the Internet evidence placed into the record by applicant shows that both applicant's and this registrant's construction trim products actually share the same material

composition (vinyl) and general function (more easily and securely finishing radial and other challenging spaces).

Registrant's drywall finishing materials formed of high impact plastic for the corners of walls and ceilings are reviewed (in the Internet hits submitted by applicant) as follows:

SBS stores statewide are now carrying the No-Coat™ Ultra Flex, which is a highly resilient plastic copolymer that is sandwiched between superior grade paper stock and joint tape paper that is hot glued and fed through an extrusion die.

<http://www.sbsalaska.com/Support/summer.html> and
<http://www.no-coat.com/products/ultraflex/index.htm>

Joint trims:

...

- Aluminum Shapes, Reveals and Trims by Gordon, Fry and Pittcon
- Flex-Bead, Strait Flex Corner Tape
- Trims for Off Angles, Radius Walls and Arches
- No Coat Ultra Flex and Ultra Flex Lite

<http://gypsumproducts.com/joint.htm>

[Registrant appears to be linked to SPECSIMPLE.com through their manufacturer locator directory]

<http://www.specsimple.com/manlocator/alphabet/uu.html>

Applicant's goods are referenced as follows:

Producing the perfect curve has just gotten easier with Ultra-Flex's all new Ultimate Flex syntactic polymer moulding.

<http://www.ultraflexmoulding.com/>

HOW TO USE ULTRA-FLEX MOULDING

ULTRA-FLEX MOULDING is designed to take the pain out of those labor intense curved surfaces and costly radius top openings.

<http://www.ultraflexmoulding.com/use.htm>

Ultra-Flex Moulding: Do you have a radius wall where you want to install crown moulding? ... This new material duplicates all the features of wood plus a degree of flexibility to accommodate the most demanding needs of the installer. Check out their Catalog.

<http://www.compoundmiter.com/links.html>

Ultra-Flex Moulding -- Ultra-Flex Moulding has developed a syntactic polymer formulation that is superior to anything on the market.

http://www.mikesart.com/linksengine/Home_Improvement/Materials/index.php?ID=3 and

<http://www.mikesart.net/>

linked to <http://www.ultraflexmoulding.com/>

Accordingly, both applicant's and this registrant's goods include interior trimming and finishing materials made of plastic (or vinyl PVC), particularly designed for difficult joints, curved surfaces and radius top openings. It seems clear from the Internet hits, the third-party registrations and the totality of the evidence in the file that registrant's goods fit the category of "moulding drywall accessories," that wallboards may be used with ceiling (or crown) and baseboard molding (consistent with applicant's identification of goods), and that as a result, drywall construction and repair are closely related activities to that of applying finishing molding.

Hence, we find that applicant's decorative molding is clearly related to the molding for suspension ceilings and the drywall trim of the cited registrations.

Channels of trade:

As to the du Pont factor directed to the channels of trade for these respective goods, absent any restrictions in any of the identifications of goods involved herein, it is clear that prospective consumers include contractors, remodelers, do-it-yourselfers, professional drywall finishers and suspended ceiling hangers. We assume all these products would be available at home improvement centers, larger lumber and construction supply houses, through online purchases, and via professional contractors and remodelers.

Sophistication of purchasers:

There is no evidence in the file as to the sophistication of any of these groups of potential consumers. Hence, because the population of potential purchasers includes the do-it-yourselfers, we have to assume an ordinary level of care by consumers in making these purchasing decisions.

Similarities of the marks:

We turn now to the similarities or dissimilarities of the marks in their entirety, as to appearance, sound and connotation.

Applicant argues that:

... its mark is distinguishable from both of the registered marks. The addition of the word "MOULDING" distinguishes it from both of the cited marks and the addition of a hyphen further distinguishes it from the second listed mark above... ."

However, as the Trademark Examining Attorney has correctly observed, applicant has disclaimed the generic term, "Moulding." While the Trademark Examining Attorney cannot ignore the word "Moulding" when comparing the marks in their entireties, disclaimed generic matter is less significant than other components of composite trademarks. Tektronix, Inc. v. Daktronics, Inc., 534 F.2d 915, 189 USPQ 693 (CCPA 1976).

While conceding that the ULTRA-FLEX portion of applicant's mark is identical to the ULTRA-FLEX mark of the '049 registration and nearly identical to the ULTRAFLEX mark of the '318 registration, applicant argues that the addition of the word MOULDING to the end of its mark creates a noteworthy distinction herein. We disagree.

We acknowledge that applicant's three-word mark looks and sounds a bit different from each of the two cited two-word marks. On the other hand, although applicant has chosen to make the word "Moulding" a part of its mark, this word in the context of this composite mark cannot provide

the degree of distinctiveness that applicant contends. Moreover, in actual practice, these components will inevitably be separated, as seen in a sentence from applicant's own webpages: "Producing the perfect curve has just gotten easier with Ultra-Flex's all new ... moulding." Moulding is the generic name of the goods, and in the marketplace, the shortened form of its trade name, "Ultra-Flex," will get separated from the word "moulding."

As to the connotation of these marks, the prefix "Ultra" suggests something that surpasses the customary norms.⁵ "Flex" is readily understood as a shortened form suggesting "flexible." Not surprisingly, applicant, like the cited registrants, touts the "degree of flexibility" or resiliency that characterize these three types of construction trim. Hence, the connotation of all these

⁵ **ultra** adj. 1. going beyond what is usual or ordinary; excessive; extreme ...

ultra-, a prefix occurring originally in loanwords from Latin, with the basic meaning "on the far side of, beyond." In relation to the base to which it is prefixed, **ultra-** has the senses "located beyond, on the far side of" (*ultramontane*; *ultraviolet*), "carrying to the furthest degree possible, on the fringe or" (*ultraleft*; *ultramodern*), "extremely" (*ultralight*); nouns to which it is added denote, in general, objects, properties, phenomena, etc., that surpass customary norms, or instruments designed to produce or deal with such things (*ultramicroscope*; *ultrasound*; *ultrastructure*)...

The Random House Dictionary of the English Language, Unabridged, 2nd Edition (1987).

marks, as applied to the respective goods on which they are used, is identical.

Having found the marks substantially the same as to meaning, sound and appearance, we conclude that these marks all create significantly similar overall commercial impressions.

Third party use and registration of ULTRAFLEX marks

The most compelling argument made by applicant relates to the du Pont factor focusing on the number and nature of similar marks in use on similar goods. In this regard, applicant has shown from the federal trademark register that ULTRA serves as a prefix to hundreds of registered marks, that there are more than a dozen variations on the ULTRAFLEX mark "in the construction and building industry," and that searches of the Internet demonstrate frequent usage of ULTRAFLEX as a trademark for a plethora of goods and as a trade name for a variety of businesses.

Consistent with the observation that applicant's TESS search revealed more than three-hundred active marks containing some variation on ULTRA in merely three international classes of building materials and fabrics (International Classes 6, 19 and 24) selected by applicant, it seems unlikely consumers accord much distinguishing

power to the word ULTRA alone. Hence, we look to the examples of a dozen marks for variations on ULTRAFLEX on what applicant has characterized as being "in the construction and building industry."

The marks shown in some of these third-party ULTRAFLEX registrations would appear to be in use as they comport exactly with some of the hits applicant pulled from the Internet. However, whether one looks to the identifications of goods from these registrations and/or learns what one can from a cursory review of the relevant Internet hit summaries, we find that applicant's goods are closely related to the goods of the cited registrations, while being more distantly related to specialized items like phosphor bronze metal strips, supply hoses for hand-held showerheads, fire-protective fabrics, exterior flashing, ceramic mortar, automotive fuel hoses, wood veneer, fiberglass fabrics, rubber hoses, environmental lining materials, vehicle body sealants, etc.

In short, we agree with applicant's general observation that a number of different manufacturers and merchants who have adopted and are using ULTRAFLEX marks appear to be coexisting in the marketplace. This du Pont factor appears to favor applicant, and it is important that we narrow appropriately the scope of protection accorded to

the cited registrations. However, we find that where the goods are as closely related as applicant's goods are to those of the two cited registrations, the existence of these third-party registrations listing quite different goods is not sufficient to overcome a conclusion of a likelihood of confusion herein based upon our weighing of the other relevant du Pont factors.

Absence of Actual Confusion

Finally, applicant has submitted an affidavit of Keith Beasley, its operations manager for the past five years, who declares that he knows of no instances of actual confusion with the cited marks. He would appear to be someone directly associated with applicant who has firsthand knowledge of whether there have been any incidents of actual confusion as a result of the contemporaneous use of the marks at issue. On yet the other hand, there is no evidence of record as to the nature and extent of the use of the respective marks. Moreover, as the Trademark Examining Attorney points out in her brief, it is unnecessary to show actual confusion inasmuch as the test under Section 2(d) of the Trademark Act is whether there is a likelihood of confusion. See Weiss

Associates Inc. v. HRL Associates Inc., 902 F.2d 1546, 14 USPQ2d 1840, 1842-43 (Fed. Cir. 1990).

In any event, while the absence of any instances of actual confusion over a significant period of time is a du Pont factor which is indicative of no likelihood of confusion, it is less meaningful herein where the evidentiary record is silent as to whether there has been appreciable and continuous use by applicant of its mark in the same markets as those served by registrants under their respective marks. See Gillette Canada Inc. v. Ranir Corp., 23 USPQ2d 1768, 1774 (TTAB 1992). In particular, there must be evidence showing that there has been an opportunity for incidents of actual confusion to occur. See Cunningham v. Laser Golf Corp., 222 F.3d 943, 55 USPQ2d 1842, 1847 (Fed. Cir. 2000). Here, there is simply no evidence in the record (i.e., information concerning details of the nature and extent of the sales and marketing activities of applicant and registrants under their respective marks) from which it could be concluded that the asserted absence of any incidents of actual confusion is indeed a mitigating factor. Compare In re General Motors Corp., 23 USPQ2d 1465, 1470-71 (TTAB 1992).

Resolving any doubt against applicant

We find that when purchasers of ULTRA-FLEX MOULDING non-metal molding encounter the marks ULTRA-FLEX for molding for suspension ceilings or ULTRAFLEX for drywall trim, they would likely believe that applicant's goods originated with or were associated with or sponsored by one of the registrants. Hence, our analysis of all the relevant du Pont factors leads us to conclude that there is a likelihood of confusion herein. To the extent that this conclusion is not free from doubt, in this proceeding, we must resolve any doubt in favor of the registrants and against applicant. In re Hyper Shoppes (Ohio) Inc., 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988), and In re Martin's Famous Pastry Shoppe, Inc., 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984).

Decision: The refusal to register applicant's mark under Section 2(d) of the Act is hereby affirmed.